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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,232	12/21/2000	Rajeev Krishnamurthi	QCPA483C	4079

23696 7590 05/08/2002

Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
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EXAMINER

SOBUTKA, PHILIP

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,232

Applicant(s)

KRISHNAMURTHI ET AL.

Examiner

Philip J. Sobutka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. Claims 1,2,5-7,10-13, are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (US 5,889,844).

Consider claims 1,6,10,11,13. Kim teaches a method for establishing a new call when an existing call is in progress comprising (Note that this constitutes a service negotiation) : delivering a first message from a mobile switching center to a base station for initiating service negotiation (Col 4, lines 23-35), negotiating a new service configuration by the base station and the subscriber (col 4, lines 36-65), and connecting the new call and existing call using the new service configuration (col 4, line 66- col 5, line 47).

As to claim 5, note that Kim's first message would function as a change service message.

As to claim 2, note that Kim's processing is performed by the MSC ( fig 3, col 3, line 65- col 4, line 2).

As to claims 7,12, note that Kim teaches call conferencing i.e. both new and existing calls are accommodated.

***Claim Rejections - 35 USC § 103***

2. Claims 3,4,8,9,14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim.

Consider claims 3,4. Kim lacks a teaching of the subscriber and base station including processors. Official Notice is taken that the use of microprocessors is well

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known in the art. It would have been obvious to one of ordinary skill in the art to modify Kim to use processors in order to perform the method using the smallest circuit configuration. Note that Kim's base stations and mobiles would include transceivers and message generators.

As to claims 8, 14, Kim lacks a teaching of using CDMA. Official Notice is taken that CDMA is well known in the art. It would have been obvious to one of ordinary skill in the art to modify Kim use CDMA in order to provide superior interference reduction and privacy.

As to claims 9, 12, note that when the subscriber required a hand-off it would be in contact with a target base station.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5,9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 2 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 2 of 6,198,929 to work with different target base station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

5. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 7 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of

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ordinary skill in the art to modify claim 7 of 6,198,929 to work with different target base station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

6. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 7 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 8 of 6,198,929 to work with different target base station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

7. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 3 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 3 of 6,198,929 to work with different target base

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station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

8. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 12 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 12 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

9. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 17 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 17 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

10. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,198,929.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 18 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 18 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

11. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 19 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 19 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

12. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 14 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall



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operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 14 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

***Information Disclosure Statement***

13. The information disclosure statement filed 7-16-2001 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copy of the reference was provided.

***Response to Arguments***

14. Applicant's arguments filed 2-25-2002 have been fully considered but they are not persuasive.

15. Note that the applicant response failed to address the double patenting rejection.

16. In response to applicant's comments regarding the rejections under 102 and 103, it appears that the applicant has a more limited definition of the term "service negotiation", involving the combination of voice and SMS or data service. Note that applicant's definition does not appear in the claims. Therefore the claims do not distinguish over Kim's combination of voice communications, or conference calling. Note also that the set up of a conference call is clearly a "service negotiation". If the

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applicant does not intend the claim to cover conference calling the claim must be amended appropriately.

***Conclusion***

17. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Sobutka whose telephone number is 703-305-4825. The examiner can normally be reached on Monday-Friday 8:30-5:00.

if attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for

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the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Philip Sobutka

Pjs  
May 5, 2002

Lee Nguyen  
Primary Examiner

